

**REMARKS**

**Summary of the Office Action**

Claims 10-12 and 14-21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-11 and 14-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,568,579 to *Mochizuki*.

Claims 20-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mochizuki*, in view of U.S. Patent No. 7,048,165 to *Haramiishi*.

**Summary of the Response to the Office Action**

Applicants amend claims 10 and 18. Claims 28-30 are added. Accordingly, claims 10-12, 14-21, and 28-30 are presently pending.

**The Rejection Under 35 U.S.C. § 112**

Claims 10-12 and 14-21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claim 18 in order to expedite the prosecution of this case. Applicants do not intend to relinquish any subject matter by these amendments. Applicants respectfully submit that claims 10-12 and 14-21 meet all the requirements of 35 U.S.C. § 112, as amended. Thus, the rejection of claims 10-21 and 14-21 under 35 U.S.C. § 112, second

paragraph, is moot. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

**The Rejections Under 35 U.S.C. § 102(e)**

Claims 10-12 and 14-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,568,579 to *Mochizuki*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Mochizuki* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(e) should be withdrawn. Newly amended independent claim 10 recites, in part, "an opening, formed at a part of the staple case, and through which a member for rotating the roll staple is brought into contact with a circumferential surface of the roll staple, wherein a direction from a center of the roll staple to the opening and a tangent line of a portion of the roll staple where the member is brought into contact with the circumferential surface of the roll staple are substantially orthogonal," as amended. *Mochizuki* fails to teach or suggest at least these features of claim 10.

The Office Action equates the opening (near roller 23) of *Mochizuki* that interfaces a flat bottom surface of "the plate-like roller guide" with the claimed "opening" recited in claim 10. *Mochizuki* does not disclose "an opening, formed at a part of the staple case, and through which a member for rotating the roll staple is brought into contact with a circumferential surface of the roll staple, wherein a direction from a center of the roll staple to the opening and a tangent line of a portion of the roll staple where the member is brought into contact with the circumferential

surface of the roll staple are substantially orthogonal,” but rather the roller (23) in *Mochizuki* is brought into contact with a plate-like roller guide on the flat bottom surface of the cartridge (4). See Fig. 4 and col. 5, lines 27-35 of *Mochizuki*. Accordingly, *Mochizuki* fails to teach or suggest each and every feature of claim 10. Thus, the rejection of claim 10 should be withdrawn.

As pointed out in M.P.E.P § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) should be withdrawn because *Mochizuki* does not teach or suggest each feature of newly amended independent claim 10.

Additionally, Applicants respectfully submit that dependent claims 11-12 and 14-19 are also allowable insofar as they recite the patentable combinations of features recited in claim 10, as well as reciting additional features that further distinguish over the applied prior art.

#### **The Rejections Under 35 U.S.C. § 103(a)**

Claims 20-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mochizuki*, in view of U.S. Patent No. 7,048,165 to *Haramiishi*. Applicants respectfully traverse the rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see M.P.E.P §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because *Mochizuki* and *Haramiishi*, whether alone or in combination, fail to teach or suggest all the recited features of independent claim 10. Newly amended independent claim 10 recites, in part, “an opening, formed at a part of the staple case, and through which a member for rotating the roll staple is brought into contact with a circumferential surface of the roll staple, wherein a direction from a center of the roll staple to the opening and a tangent line of a portion of the roll staple where the member is brought into contact with the circumferential surface of the roll staple are substantially orthogonal.” *Mochizuki* or *Haramiishi*, whether taken alone or in combination, fail to teach or suggest at least these features of claim 10.

As previously demonstrated, *Mochizuki* fails to teach or suggest each and every feature of claim 10. *Haramiishi* does not cure this deficiency in *Mochizuki*. Thus, the rejection of claim 10 should be withdrawn.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Mochizuki* or *Haramiishi*, whether taken alone or in combination, fails to teach or suggest fail to teach or suggest each feature of newly amended independent claim 10, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claims 20-21 depend from independent claim 10. Accordingly, claims 20-21 are also allowable because of the additional features they recite and the reasons stated above.

**New Claims**

Applicants respectfully request allowance of dependent claims 28-30, which depend from newly amended independent claim 10, respectively. The claims are allowable insofar as they recite the patentable combinations of features recited in their base claim 10, as well as reciting additional features that further distinguished over the applied prior art.

Accordingly, in view of the above amendments, claims 28-30 are allowable and pending for further consideration.

**Conclusion**

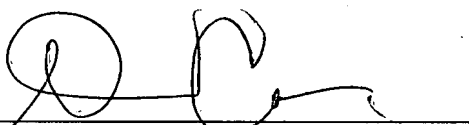
In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of all pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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